

## REMARKS

In view of the above amendments and the following remarks, reconsideration and allowance of this application are requested. Claims 1, 3, 5, 6, and 8-10 are pending with claims 1, 3, 5, 9 and 10 being independent. No new matter is introduced by any claim amendment presented herein.

### Rejection Under 35 U.S.C. §112

In the Office Action dated September 4, 2003 claims 1, 3, 6, 9 and 10 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1, 9 and 10 have been amended as suggested by the Examiner. Applicants submit that amended claims 1, 9 and 10 clarify the Markush language with respect to "R", and therefore the rejection under 35 U.S.C. §112, second paragraph should be withdrawn. Support for this amendment is found in the specification at least at page 8, lines 1-2 and claims as filed.

Claim 3 does not contain a Markush language, hence no amendment is necessary.

Claim 6 is directed to a pharmaceutical composition comprising a compound of claim 1 or 3, and therefore incorporates the limitation of claims 1 and 3, which have been amended by this amendment.

In addition, claim 5 is also amended which also contains a Markush language. This amendment is supported by the original specification as filed. Applicants respectfully submit that the instant rejections have been overcome by applicants' amendments to the claims, and that the rejection should be reconsidered and withdrawn.

### Rejection Under 35 U.S.C. §103(a) over Ishizumi et al. (United States Patent No. 4,598,078 or Chem. Pharm. Bull., v. 39(9), (1991) 2288-2300)

Claims 1-3, 6, 9 and 10 have been rejected under 35 U.S.C. §103(a) as obvious over Ishizumi et al. Applicants respectfully traverse the rejection for the following reasons.

Claims 1, 3, 6, 9 and 10 as presented herein are unobvious over

Ishizumi et al. As is well known, to establish a prima facie case of obviousness, three criteria must be met. First, there must be motivation in the prior art references to modify the reference. Second, there must be a reasonable expectation of success and third, the prior art reference must teach or suggest all the claimed limitations. In this connection, all the teachings and suggestions as well as the expectation of success must come from the prior art and not from the applicants' disclosure.

There is no suggestion in Ishizumi et al. of the desirability of modifying the compounds or methods disclosed in these references to obtain the novel compounds or methods for the high  $\alpha_1$ -AR selectivity for use in BPH disclosed in the present invention. There is no suggestion or motivation in the prior art of record to provide, for example, disubstituted phenyl substituents as R in applicants' Formula I. There is no suggestion or motivation in the prior art of record to provide, for example, hydroxy, nitro or trifluoroalkyl as monosubstituents for phenyl as R in applicants' Formula I. There is no suggestion or motivation in the prior art of record to provide, for example, the particular compounds of claim 3 as amended herein.

Further, it is clear that neither problem nor solution is discernible to one with ordinary skill in the art from the teachings of prior art references. Applicants respectfully submit that a prima facie case of obviousness of the claims over the cited prior art has not been made. Applicants respectfully request reconsideration and withdrawal of the rejections.

Applicants submit that the claims are supported by the disclosure as filed, and respectfully request reconsideration and withdrawal of the rejection. This would overcome all outstanding rejections and result in allowable claims.

#### Allowable Subject Matter

As noted in the Office Action dated September 4, 2003, there was an

inadvertent error in rejection of claim 8 in the previous action, and applicants thus respectfully request withdrawal of the rejection. Further, claim 5 has not been rejected in this Office Action. Like claim 8, independent claim 5 also recites a method of treatment. Thus, for at least this reason, claim 5 is allowable.

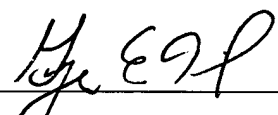
### Conclusion

For the reasons stated above, the Examiner is urged to pass claims 1, 3, 5, 6, and 8-10 to issue immediately.

In response to the outstanding Office Action, dated September 4, 2003, submitted herewith is a Petition for Extension of Time from December 4, 2003 to March 4, 2004. This Petition includes an authorization to charge the required fee. Authorization is hereby given to charge any fees deemed to be due in connection with this Amendment and Response to Office Action to Deposit Account No. 50-0912.

Respectfully submitted:

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